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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/896,514	06/23/1997	CONRAD OLIVER GARDNER	95-004M	3272

7590 02/16/2006

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Communication Re: Appeal	Application No.	Applicant(s)	
	08/896,514	GARDNER, CONRAD OLIVER	
	Examiner	Art Unit	
	Lesley D. Morris	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☒ The Notice of Appeal filed on 08 November 2005 is not acceptable because:

- (a) ☐ it was not timely filed.
- (b) ☒ the statutory fee for filing the appeal was not submitted. See 37 CFR 41.20(b)(1).
- (c) ☐ the appeal fee received on _____ was not timely filed.
- (d) ☐ the submitted fee of \$_____ is insufficient. The appeal fee required by 37 CFR 41.20(b)(1) is \$_____.
- (e) ☐ the appeal is not in compliance with 37 CFR 41.31(a)(1) in that no claim has been twice rejected.
- (f) ☐ a Notice of Allowability, PTO-37, was mailed by the Office on _____.

2. ☒ The appeal brief filed on 17 November 2005 is NOT acceptable for the reason(s) indicated below:

- (a) ☐ the brief and/or brief fee is untimely. See 37 CFR 41.37(a).
- (b) ☒ the statutory fee for filing the brief has not been submitted. See 37 CFR 41.20(b)(2).
- (c) ☐ the submitted brief fee of \$_____ is insufficient. The brief fee required by 37 CFR 41.20(b)(2) is \$_____.

The appeal in this application will be dismissed unless corrective action is taken to timely submit the brief and requisite fee. See 37 CFR 41.37(a)(1). Extensions of time may be obtained under 37 CFR 1.136(a). See 37 CFR 41.37(e).

3. ☐ The appeal in this application is DISMISSED because:

- (a) ☐ the statutory fee for filing the brief as required under 37 CFR 41.20(b)(2) was not timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
- (b) ☐ the brief was not timely filed and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
- (c) ☐ a Request for Continued Examination (RCE) under 37 CFR 1.114 was filed on _____.
- (d) ☐ other: _____.

4. ☐ Because of the dismissal of the appeal, this application:

- (a) ☐ is abandoned because there are no allowed claims.
- (b) ☒ is before the examiner for final disposition because it contains allowed claims. Prosecution on the merits remains CLOSED.
- (c) ☐ is before the examiner for consideration.

Art Unit: 3611

Applicant may not request a reinstatement of the previous Appeal because a preliminary decision was reached and a new rejection under 37 CFR 41.50(b) was entered by the Board of Appeals. Instead, Applicant must file a New Notice of Appeal and Appeal Brief accompanied by the appropriate fees. Please consult MPEP 1214.01 titled "Procedure Following New Ground of Rejection by Board" which specifically states "If the rejection under 37 CFR 41.50(b) is not overcome, the applicant can file a second appeal." In this instance, it was determined that the affidavit was not persuasive and the rejection was made final. MPEP 1214.01 further states "An applicant in whose application such a final rejection has been made by the examiner may mistakenly believe that he or she is entitled to review by the Board of the rejection by virtue of the previous appeal, but under the provisions of 37 CFR 41.50(b)(1), after such a final rejection, an applicant who desires further review of the matter must file a new appeal to the Board. Such an appeal from the subsequent rejection by the examiner will be an entirely new appeal involving a different ground and will require a new notice of appeal, appeal brief, and the payment of the appropriate fees." Thus, a \$250 Appeal fee and a \$250 Appeal Brief are due along with any extensions of time necessary.

Any inquiry concerning this communication should be directed to Lesley D.

Morris at telephone number 571 272-6651.



Lesley D. Morris
SPE
Art Unit 3611

request for rehearing under 37 CFR * > 41.50(b)(2) <, must be filed within 2 months from the date of the Board's decision. In accordance with 37 CFR 1.196(f), this 2-month time period may not be extended by the filing of a petition and fee under 37 CFR 1.136(a), but only under the provisions of 37 CFR 1.136(b), or under 37 CFR 1.550(c) if the appeal involves an *ex parte* reexamination proceeding.

If an appellant files an appropriate amendment or ** > new evidence < (see paragraph I below) as to less than all of the claims rejected by the Board under 37 CFR * > 41.50(b) <, and a request for rehearing (see paragraph II below) as to the remainder of the claims so rejected, the examiner will not consider the claims for which rehearing was requested. The request for rehearing will be considered by the Board after prosecution before the examiner with respect to the first group of claims is terminated. Argument as to any of the claims rejected by the Board which is not accompanied by an appropriate amendment or ** > new evidence < as to those claims will be treated as a request for rehearing as to those claims.

I. SUBMISSION OF AMENDMENT OR ** > NEW EVIDENCE <

37 CFR * > 41.50(b)(1) < provides that the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board, "or ** > new evidence < relating to the claims so rejected, or both." An amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims. *Ex parte Comstock*, 317 O.G. 4, 1923 C.D. 82 (Comm'r Pat. 1923). An amendment which adds new claims without either amending the rejected claims, or substituting new claims for the rejected claims, is not appropriate. The new claims will not be entered, and the examiner should return the application file to the Board for consideration of the amendment as a request for rehearing under 37 CFR * > 41.50(b)(2) <, if it contains any argument concerning the Board's rejection. The "** > new evidence < " under the rule may be a showing under 37 CFR 1.130, 1.131 or 1.132, as may be appropriate.

If the appellant submits an argument without either an appropriate amendment or ** > new evidence < as to any of the claims rejected by the Board, it will be treated as a request for rehearing under 37 CFR * > 41.50(b)(2) <.

The new ground of rejection raised by the Board does not reopen * prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under 37 CFR * > 41.50(b) < was made includes an affirmation of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmation of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmation need be filed at that time. Prosecution before the examiner of the 37 CFR * > 41.50(b) < rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR * > 41.50(b) < rejection. If the application becomes allowed, the application should not be returned to the Board. Likewise, if the application is abandoned for any reason, the application should not be returned to the Board. If the rejection under 37 CFR * > 41.50(b) < is not overcome, the applicant can file a second appeal (as discussed below). Such appeal must be limited to the 37 CFR * > 41.50(b) < rejection and may not include the affirmed rejection. If the application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR * > 41.50(b) < is terminated before the examiner, the application file must be returned to

MPEP
1214.01

Procedure

Following
New
Ground
of
Rejection
by
Board

the Board so that a decision making the original affirmance final can be entered.

The time for filing a request for rehearing on the affirmance or seeking court review runs from the date of the decision by the Board making the original affirmance final. See MPEP § 1214.03 and § 1216.

If the examiner does not consider that the amendment and/or **>new evidence<** overcomes the rejection, he or she will again reject the claims. If appropriate, the rejection will be made final.

An applicant in whose application such a final rejection has been made by the examiner may mistakenly believe that he or she is entitled to review by the Board of the rejection by virtue of the previous appeal, but under the provisions of 37 CFR **> 41.50(b)(1)<**, after such a final rejection, an applicant who desires further review of the matter must file a new appeal to the Board. Such an appeal from the subsequent rejection by the examiner will be an entirely new appeal involving a different ground and will require a new notice of appeal, appeal brief, and the payment of the appropriate fees.

II. REQUEST FOR REHEARING

Instead of filing an amendment and/or **>new evidence<** under 37 CFR **>**

41.50(b)(1)<, an appellant may elect to proceed under 37 CFR **> 41.50(b)(2)<** and file a request for rehearing of the Board's new rejection. The rule requires that the request for rehearing "must address the new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought." By proceeding in this manner, the appellant waives his or her right to further prosecution before the examiner. *In re Greenfield*, 40 F.2d 775, 5 USPQ 474 (CCPA 1930). A request for rehearing accompanied by an appropriate amendment of the claims rejected by the Board, and/or by **>new evidence<**, does not constitute a proper request for rehearing under 37 CFR **>41.50(b)(2)<**, and will be treated as a submission under 37 CFR **> 41.50(b)(1)<**.

If the Board's decision also includes an affirmance of the examiner's rejection, a request for rehearing of the affirmance (see MPEP § 1214.03 and MPEP § 1214.06, paragraph IV) should be filed in a separate paper to facilitate consideration.

1214.03 [R-3] Rehearing

37 CFR 41.52. **> Rehearing.**

(a)

(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

(2) Upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(3) New arguments responding to a new ground of rejection made pursuant to § 41.50(b) are permitted.

(b) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.<

The term "rehearing" is used in 37 CFR **>41.52<** for consistency with the language of 35 U.S.C. 6(b). It should not be interpreted as meaning that an appellant is entitled to an oral hearing on the request for rehearing, but only to a rehearing on the written record.